

REMARKS/ARGUMENTS

The Office Action of November 22, 2005 has been carefully reviewed and these remarks are responsive thereto. Claims 1-11, 17-28 and 30-37 remain pending in this application upon entry of this response. Reconsideration and allowance of the instant application are respectfully requested.

Applicants acknowledge, with appreciation, the Examiner's indication that all of the claims are allowable over the art of record. A single issue remains with respect to claims 1-11, 17-28 and 30-37. This issue is addressed below.

Rejection under 35 U.S.C. § 101

The Office rejects claims 1-11, 17-28 and 30-37 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. The Office Action, on page 2, asserts that the claimed invention fails to produce a useful, concrete and tangible result. Applicants respectfully disagree.

The specification as filed indicates a multitude of uses of the various aspects of the invention, including, for example, creating a portfolio for a hypothetical collection of stocks for monitoring market trends and/or to test out new investment strategies without risk. (Page 2, lines 18-19). The Court of Appeals for the Federal Circuit, in *State Street Bank & Trust Co. v. Signature Financial*, held that "the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula or calculation because it produces 'a useful, concrete and tangible result' – a final share price momentarily fixed for recording and reporting purposes." 149 F.3d 1368, 1373 (Fed. Cir. 1998). The present invention provides methods, systems and computer-readable media for creating a portfolio. Similar to the invention in *State Street*, the present invention also transforms data, in some cases representing discrete dollar amounts, by a machine through a series of mathematical calculations. A user may input various criteria, such as number of shares to purchase or total value of the portfolio, and the computer, via a series of mathematical calculations, will transform this user input into a portfolio having a current value based on additional information obtained, such as stock price, date and exchange on which the shares are traded. The portfolio created may supply useful and concrete

information, such as current value information, as well as number of shares purchased, number of shares owned, portfolio value at its creation, and the like. Hence, the transformation of user input data and additional stock data into a personal portfolio containing information necessary to make stock transaction decisions, and the capability of presenting such information to users, provides “useful, concrete and tangible results.”

The Office Action further alleges on page 2 that the “portfolio remains in the computer and therefore is not a concrete and tangible result.” Applicants respectfully disagree. There is no legal requirement that, in order for the invention to have a concrete and tangible result, the information may not remain in the computer. For example, the final share price generated by the computerized accounting system of *State Street* was not embodied in a structure outside the computer. Nonetheless, the Court still held the *State Street* invention to constitute statutory and patentable subject matter. Following the holding of the Court in *State Street*, the systems, methods and computer-readable media according to the present invention should not be held unpatentable simply because the resulting portfolio may remain in the computer.

Quite simply, the claims in this application clearly recite patentable subject matter. Independent method claims 1 and 34 recite various steps of “receiving user input.” These method claims further recite the step of creating the portfolio and calculating its past performance based on the inputs. As described above, creation of the portfolio and calculation of its past performance provides users with useful, concrete, and tangible results (*e.g.*, they produce useful and concrete information relating to the portfolio and make it available to users in a tangible form, *e.g.*, displayed on a computer screen and/or stored in computer memory). Accordingly, these method claims clearly recite statutory and patentable “processes” within the meaning of 35 U.S.C. § 101.

Similarly, independent computer-readable medium claims 17 and 30 recite computer-readable media storing computer-executable programs for performing useful methods and providing useful, concrete and tangible results of the types described above with respect to claims 1 and 34. Such claim formats have long been recognized as proper by the USPTO and as containing statutory subject matter. *See In re Beauregard*, 53 F.3d 1583 (Fed. Cir. 1995).

Furthermore, Applicants' independent system claim 28 clearly recites statutory subject matter. This claim recites an input system for receiving user input for creating a portfolio and a processor for determining the number of shares and past performance data relating to the portfolio based on the input. Clearly computer systems of this type, including the recited hardware, produce useful, concrete, and tangible results as described above and constitute patentable subject matter within the meaning of 35 U.S.C. § 101.

In view of the foregoing, Applicants respectfully submit that the claims in this application clearly define statutory subject matter. Withdrawal of this rejection and allowance of claims 1-11, 17-28, and 30-37 are earnestly solicited.

CONCLUSION

Applicants believe that no fee is required for this submission. However, if any fees are required, such as fees under 37 C.F.R. §§ 1.16 or 1.17, or if an extension of time is necessary that is not accounted for in the papers filed with this Amendment, the Commissioner is authorized to debit our Deposit Account No. 19-0733 for any necessary fees, including any necessary extension fees.

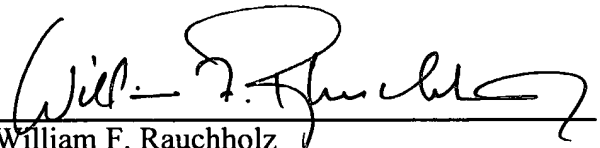
All rejections having been addressed, Applicants respectfully submit that this application is in condition for immediate allowance and respectfully solicit prompt notification of the same.

Respectfully submitted,

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